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| 09/577,221 | 05/23/2000 | Michael A. Rolenz | D-375 | 4189 |

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| EXAMINER |
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BELLO, AGUSTIN

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| ART UNIT | PAPER NUMBER |
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2633

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/577,221 | Applicant(s) ROLENZ, MICHAEL A. | |
| | Examiner Agustin Bello | Art Unit 2633 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/07/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), *at the time the application was filed*, had possession of the claimed invention. The specification is silent to asynchronously communicating the digital laser signal over the communication medium.

4. The applicant has amended the specification to include subject matter that was not described in the originally filed specification. As such, the amendment to the specification and the claims directed to the newly added subject matter consist of "new matter" which is not permitted. While the applicant argues that the specification as originally filed implies asynchronous communication (e.g. "no need for synchronous communication"), the examiner

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maintains that subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention. For example, the statement, "no need for synchronous communication" would not direct one skilled in the art to the automatic conclusion that asynchronous communication is called for. This is particularly true considering that the applicant discloses that "the data stream is self synchronizing" (page 12 lines 1-9 of the specification). Given the apparent lack of a clear written description which positively demonstrates that the applicant had possession of the claimed invention at the time the application was filed, the examiner has ignored the new matter added to the specification and claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauducel et al in view of Palmer.

Beauducel et al teaches

a system for communicating an analog input signal (abstract) as a modulated binary signal (abstract) over a communication medium (col. 3- lines 59-62) recovered as an output digital signal, the system (fig. 2) comprising

a sigma delta modulator (AE in fig. 2) for receiving the analog input signal and modulating the analog signal into a modulated symbol signal,

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a transmitter (7) for converting the modulated symbol signal into the modulated binary signal (col. 3- lines 59-62), and for transmitting the modulated binary signal over the communication medium(col. 3- lines 59-62), the modulated binary laser signal having a pulse width having a duration representative of the analog input signal (inherent in modulation),

a receiver (8) for receiving and detecting the modulated binary signal for providing a received symbol signal, and

a digital filter (10) for filtering the symbol signal into the digital output signal.

Beauducel et al does not specify a modulated binary laser signal. However, Beauducel et al does suggest that one of many different types of transmitters is to be used including optical (col. 3- line 62). Further, Palmer et al. teaches a communication system wherein a sigma-delta modulator (26, and col. 3- lines 44-46) is used with a laser transmitter (34 and 36). Official notice is taken that lasers are notoriously used in optical transmitters, and are advantageous because they have a long coherence length and therefore may be used to transmit phase information, they are able to maintain spatial power-distribution for long distances allowing for long transmission distances over free-space or waveguides, and they enable one skilled in the art to pack a large number of wavelength channels close together (spectrally) in a transmission system, due to the narrow spectral bandwidth of lasers. At the time the present invention was made, it would have been obvious to one having ordinary skill in the art to use a laser to transmit a modulated binary laser signal, in order to realize any of the advantages cited above and widely known in the art.

Regarding claim 8, Beauducel et al teaches in the system the communication medium being fiber optic (claim 15 in Beauducel et al).

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7. Claims 2-4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauducel et al in view of Palmer as applied to claim 1 above and further in view of Potratz et al.

Regarding claim 2, the combined teaching of Beauducel et al and Palmer specifically includes a symbol to binary converter for converting the modulated symbol signal (oversampled analog signal, in abstract) from the sigma-delta modulator into a converted digital signal (lower resolution digital words, in abstract). Though a symbol to binary converter is not mentioned per se, one is inherently disclosed by disclosing the function performed above, as means are necessary to perform the function. Accordingly, Beauducel et al's teaching accounts for producing binary signals from the symbol signals produced the sigma-delta modulator. Either this function is incorporated into the sigma-delta modulator, in the transmitter (7) or otherwise, mention of particular means is omitted from Beauducel et al, since it would be inherent to the teaching of transmitting digital signals, to include said means.

The teaching of Beauducel et al and Palmer does not specify a pulse width modulator for modulating the laser signal by the converted digital signal into the modulated binary laser signal as a pulse width binary modulated laser signal communicated over the communication medium. However, Beauducel et al does suggest that the transmitter (7) include a modulator to modulate an optical signal (col. 3- lines 59-63), without specifying the type of modulation. Further, Potratz teaches a system for communicating an analog input signal as a binary optical signal (fig. 1), wherein a sigma-delta modulator is employed with a pulse-width modulator that modulates an optical signal.

At the time the present invention was made, it would have been obvious to one having ordinary skill in the art to further modify the teaching of Beauducel et al and Palmer to include a

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pulse-width modulator in the transmitter, as taught in Potratz. The signal of the modified teaching must be represented somehow on a laser carrier. The choice of pulse-width modulation is a design choice, and would have been altogether obvious to one having ordinary skill in the art. One having ordinary skill in the art would have been motivated to use pulse-width modulation, for instance, to represent the long words of binary bits that the system of Beauducel et al transmits (abstract) by using NRZ, which in effect is pulse width modulation (the longer the pulse, the greater the number of binary 1's in a word). This is known to utilize less bandwidth. However, this being a design choice, it depends entirely on the intended use of the system and the type of data to be transmitted.

Regarding claim 3, the means in the receive side recited correspond to reversing the signal processing steps applied in the transmit side. Though the combined teaching of Beauducel, Palmer and Potratz does not specifically disclose that the receiver comprises a pulse width detector receiving the pulse width modulated binary laser signal and for providing a detected binary signal, generally a pulse-width modulator is used in the art in combination with a pulse-width demodulator. Accordingly, it would have been obvious, if not inherent to the teaching, for one having ordinary skill in the art to include a pulse-width detector in the modified receiver of Beauducel et al, Palmer and Potratz (8) where a pulse-width modulator is present in the transmitter (7), in order to decode the pulse-width information. The combined teaching of Beauducel, Palmer and Potratz does not specifically mention per se a binary to symbol converter for converting the detected binary signal into the received symbol signal. However, Beauducel et al does teach that the function is performed in the system; lower resolution words are converted

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to higher resolution words (abstract). Accordingly, means to perform the function are inherent to the disclosure. In this case, the digital filter performs the function.

Regarding claim 11, the claim recites the same limitations recited in claim 3 with the base claims of claim 3.

Regarding claim 4, quantization is inherent to any conversion from analog to digital signals. Accordingly, the pulse width detector is a pulse width quantizer detector, the detected binary signal is a detected quantized signal, the binary to symbol converter converts the detected quantized signal into the received symbol signal.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beauducel et al in view of Palmer as applied to claim 1 above, and further in view of Scott et al.

The combined teaching of Beauducel et al and Palmer does not include a timing recovery loop for generating a timing signal from the received symbol signal for clocking the digital filter. Scott teaches a transmission signal that utilizes a sigma-delta modulator, wherein in the receiving side, a timing recovery loop (707) for generating a timing signal from the received symbol signal is used for clocking different elements (fig. 7, col. 5- lines 7-12). Scott teaches that using this timing recovery loop minimizes effects of any timing jitter during transmission (col. 5- lines 7-12). At the time the present invention was made, it would have been obvious to one having ordinary skill in the art to use the timing recovery loop taught in Scott to drive the digital filter in the combined teaching of Beauducel et al and Palmer in order to minimize the effects of timing fitter as taught in Scott resulting in lower error in receiving the data.

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9. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beauducel et al in view of Palmer as applied to claim 1 above, and further in view of applicant's admitted prior art (AAPA) (fig. IA- 1B, pages 6-7).

The combined teaching of Beauducel et al and Palmer does not specify first or second order sigma-delta converters. However, AAPA shows both types of sigma-delta modulators as well known in the prior art and used in data transmission.

Regarding claim 6, it would have been obvious to one having ordinary skill in the art to use a first order sigma-delta modulator as known in the art at the time the present invention was made (as admitted by applicant) in the system of the combined teaching of Beauducel et al and Palmer, because a first order sigma-delta modulator is the simplest sigma-delta modulator and requires the least number of parts. Hence it offers one having ordinary skill in the art the advantage of lower cost and/or simpler assembly in the event that the level of error offered by a first order sigma-delta modulator is sufficient for the specific needs of the system (this being a matter of design choice).

Regarding claim 7, it would have been obvious to one having ordinary skill in the art to use a second order sigma-delta modulator as known in the art at the time the present invention was made (as admitted by applicant) in the system of the combined teaching of Beauducel et al and Palmer, because a second order sigma-delta modulator results in a smaller error at the output of the modulator (AAPA, page 7- lines 3-5). One having ordinary skill in the art would have been motivated to use a second order sigma delta modulator in the event where a smaller error was needed to meet the demands of the system (the level of tolerance for error being entirely a matter of design choice and depends on the application and other considerations).

Response to Arguments

10. Applicant's arguments with respect to the newly added claims 14-15 have been considered but are moot in view of the new ground(s) of rejection (e.g. the 112 rejection above).

11. Applicant's arguments filed 12/7/05 have been fully considered but they are not persuasive in view of the 112 rejection above.

12. Applicant's arguments filed 1/10/05 have been fully considered but they are not persuasive. In response to applicant's argument that the prior art cited by the examiner fails to specifically teach a sigma delta modulator for generating a pulse width modulated binary signal for representing an analog input, which binary signal can be communicated without synchronization, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

13. Applicant's arguments filed 5/17/04 have been fully considered but they are not persuasive. The applicant has failed to amend the claims in a manner which presents patentable subject matter. The applicant essentially argues that examiner has engaged in impermissible hindsight in combining the cited references. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

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upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The examiner maintains that the combination of references teach the claimed invention and that the examiner has taken into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. As such, the reconstruction is proper.

14. In response to applicant's argument that the combination of Beauducel and Palmer fails to obviate the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

15. In response to applicant's argument that the examiner has failed to recognized the problem solved and the solution, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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16. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

17. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

18. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

19. Applicant's arguments filed 10/2/03 have been fully considered but they are not persuasive. The applicant argues that the examiner has failed to provide reason for using a binary modulated laser signal. However, the opposite is true. The examiner clearly states in the office action that it would have been advantageous for one skilled in the art to use a laser for transmission of the binary signal being that lasers well known to have a long coherence length, they are able to maintain spatial power distribution for long distances, and they allow for wavelength division multiplexing. Furthermore, Beauducel clearly suggests that a variety of different transmitters could be used depending upon the application of the system (column 3 lines 59-62). Based on this suggestion, the examiner turns to Palmer to show that it is well known in the art to combine a sigma delta modulator and a laser in an optical transmission system. That Beauducel suggests a sigma delta modulator connected to some type of optical

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transmitter and Palmer explicitly teaches the use of a sigma delta modulator and a laser for the transmission of an optical communication signal directly contradicts the applicant's assertion that Palmer is no way relevant to the invention of Beauducel.

20. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., On/off binary modulation, asynchronous transmission) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

21. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agustin Bello whose telephone number is (571) 272-3026. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (571)272-3022. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB


AGUSTIN BELLO
PRIMARY EXAMINER